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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,648	03/01/2000	Roger P Hoffman	P/2-61	3239

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EXAMINER
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ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/516,648	HOFFMAN, ROGER P	
	Examiner	Art Unit	
	Kevin R Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7,8,10-20 and 22-28* is/are pending in the application.

4a) Of the above claim(s) *24-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7,8,10-20,22 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 24-28 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12/03/2001.

Claim Rejections - 35 USC § 112

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "publication grade paper" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning. Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contains an improper Markush group. The claims should state that the coating is "selected from the group consisting of clay, protein, starch, titanium dioxide, ***and*** mixtures thereof."

4. The rejection of claims 2 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention has been overcome by amendment. Applicant has canceled claims 2 and 21.

5. The rejection of claim 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by amendment. Applicant has canceled claim 9.

Claim Rejections - 35 USC § 103

6. Claims 1, 3, 4, 7, 8, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173) for reasons of record.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1, 3, 4, 7, 8, 10, 12, and 13 for reasons of record.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1, 3, 4, 7, 8, 10, 12, and 13 and further in view of Holder Jr. (US 3,982,056) for reasons of record.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1, 3, 4, 7, 8, 10, 12, and 13 above for reasons of record.

10. Claims 15, and 17-19 are rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1, 3, 4, 7, 8, 10, 12, and 13 above, and further in view of Confer (US 3,603,501) for reasons of record.

11. Claims 15-20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1, 3, 4, 7, 8, 10, 12, and 13 above, and further in view of Knudson et al. (US 4,913,773) for reasons of record.

Response to Arguments

Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive.

Applicant argues that "publication grade paper" is definied on page 5 of the specification as label paper or other printing and writing grades of paper. The examiner respectfully disagrees. The specification states that the paper sheet may comprise "publication or lable paper or other printing and writing grades of paper." The specification lists writing grades of paper and label paper as alternatives to publication grade paper, not as examples of publication grade paper or as a definition of publication grade paper. Thus, the disclosure of page 5 fails to overcome the outstanding 35 U.S.C.112, second paragraph rejection. Applicant further argues that the disclosure on page 11 renders the phrase definite. The examiner respectfully disagrees. Page 11 states that the surfaces may appear as a "plain publication grade paper, such as MG or MF or other printing, writing or lable grades, or may have printed graphics thereon."

However, examples do not constitute a definition. Thus, applicant's argument is not persuasive.

With respect to the rejections based upon the teachings of Cavagna in view of Peer, Applicant argues that the combination of references would not motivate one of ordinary skill in the art to attach a film to the bleached cellulosic fiber layer of Peer because Peer teaches the application of a film to only unbleached papers. The examiner does not agree with Applicant's characterization of the Peer reference. Peer teaches the application of plastic film over outer packaging paper materials (see Background of the Invention and Summary of the Invention). Thus, Peer would have motivated one of ordinary skill in the art to apply a film to the outer surface of a packaging paper. In Cavagna, the outer surface of the packaging paper is a bleached paper. Furthermore, the teachings of Peer are not limited to unbleached paper substrates. Peer defines the "paper material" as any web of cellulose fibers (col 5, lines 11+).

Applicant further argues that there is nothing in Cavagna that suggests the need for further layer(s) to help with tear resistance. The examiner notes that the rejection does not rely upon Cavagna for such a teaching. Peer was relied upon to teach that the application of a film to the outer surface of a paper packaging material increases the packaging material's tear resistance. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to claims 3, 4, 5, 7, 8, 12, 13, and 14, Applicant argues that the claims are allowable because Cavagna in view of Peer does not meet the limitations of claim 1. The rejections are maintained for the reasons stated above.

With respect to claim 10, Applicant argues that Cavagna in view of Peer does not teach a paper sheet with a coating. The examiner respectfully disagrees. The examiner takes the position that the adhesive and the film rendered obvious by Peer read on the claimed coating of claim 10.

With respect to claims 15 and 17-19, Applicant argues that Cavagna does not teach that two additional layers may be added to the laminate. The examiner agrees, but notes that the rejection never relied upon Cavagna for such a teaching. Rather, the examiner relied upon Confer to motivate one of ordinary skill in the art to add the claimed layers. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the combination of Cavagna in view of Peer and Knudson fails to render claim 20 obvious. The examiner respectfully disagrees. Cavagna in view of Peer is relied upon as above. Knudson teaches a multi-ply paperboard comprising one ply of high bulk fibers sandwiched between at least two plies of conventional

papermaking fibers (abstract). A bonding agent may be utilized between the layers (col 5, lines 3-17). Said paperboard has superior stiffness in comparison to traditional paperboard. Stiffness is important in folding carton applications (col 3, lines 3-5). Thus, the examiner maintains the position that it would have been obvious to one of ordinary skill in the art to utilize the multiply paperboard taught in Knudson in the laminate taught in Cavagna to increase the stiffness of the laminate.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

K-R K-

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